

REMARKS/ARGUMENTS

Claims 1-7 are pending in the present application. Claims 8-20 are canceled. Claims 1 and 5 are amended. Applicants are not conceding in this application that those claims are not patentable, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the remaining claims. Applicants respectfully reserve the right to pursue these and other claims, including the subject matter presented prior to this Amendment, in one or more continuations and/or divisional patent applications. Support for amendments to the claims is located at least in the previous draft of the claims and in the specification on page 9, line 27, through page 11, line 9; on page 12, lines 5-28; on page 13, lines 5-14; on page 17, lines 12-29; on page 18, lines 1-20; on page 19, line 18, though page 20, line 27; and in **Figures 4, 5 and 6**. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 1, 3-4, and 6-8 under 35 U.S.C. § 103 as being unpatentable over Gillespie, U.S. Patent Application Publication No. 2005/0043985 (hereinafter “*Gillespie*”). This rejection is respectfully traversed.

The Examiner states:

Claim 1: Gillespie discloses a method in a data processing system for providing a consulting assessment environment, the method comprising:

- receiving data about a business through a questionnaire, wherein the questionnaire is defined by a data template (see paragraph 36: lines 10-23, disclosing a survey system to present questions and receive responses regarding a business; paragraph 37, disclosing customizing the survey questions);
- computing at least one assessment score based on formulas in an assessment framework template (see paragraph 38 : lines 1-15, disclosing evaluating responses and generating a score based on the responses; paragraphs 43-51, disclosing specific calculations)
- determining an appropriate action based on the at least one assessment score and a suggested actions template (see paragraph 38: lines 8-15, disclosing providing the user with a recommendation; paragraph 43); and
- reporting results based on the at least one assessment score and the appropriate action in accordance with a report template, wherein the assessment framework template and the suggested actions template encode business-related domain knowledge (see paragraph 38: lines 8-30, disclosing reporting results to users; paragraph 52; paragraph 56) including at least one of best practices,

business consultant expertise, and business goals (see paragraph 37: disclosing customizing a survey and evaluation based on an administrator's input).

Gillespie does not explicitly disclose wherein proprietary information and trade secrets of the consulting assessment environment are hidden from clients. However, Gillespie does teach limiting data access to authorized users (see ¶¶ 38, 56-57, and 82).

Examiner takes Official Notice that it was well-known in the arts at the time the invention was made to limit access to confidential data. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to hide confidential data from clients when performing the method of Gillespie. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security.

Claim 3: Gillespie discloses identifying benefits and risks based on the at least one assessment score and the appropriate action (see paragraphs 39, 52, and 56, disclosing determining the merits and costs; paragraph 54).

Claim 4: Gillespie discloses consolidating portions of the results together for further analysis (see paragraph 38: lines 15-19; paragraphs 42 and 54).

Claim 6: Gillespie discloses wherein the data template includes at least one of interview questions (see paragraph 37), weighing factors (see paragraph 37), desired states, benefit descriptions (see paragraph 54), risk descriptions, suggested actions (see paragraph 42), cost areas (see paragraph 54), and terminology.

Claim 7: Gillespie discloses wherein the assessment framework template includes at least one of scoring information (see paragraphs 43-51), calculations (see id.), suggested actions logic (see id.), benefit and risk logic (see id.), user feedback (see id.), and user input (see id.).

Claim 8: Gillespie does not explicitly disclose wherein the proprietary information and the trade secrets of the consulting assessment environment that are encoded in any of the data template, the assessment framework template, the suggested actions template, and the report template are made inaccessible to the clients. However, Gillespie does teach limiting data access to authorized users (see ¶¶ 37-38, 56-57, and 82).

Examiner takes Official Notice that it was well-known in the arts at the time the invention was made to limit access to confidential data. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to hide confidential data from clients when performing the method of Gillespie. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security.

Final Office Action dated September 18, 2008, pp. 2-5.

As amended, independent claim 1 reads as follows:

1. A method in a data processing system for providing a consulting assessment environment, the method comprising:
 - determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic and conducting a self-assessment, wherein defining assessment business logic is performed by a consultant, wherein conducting a self-assessment is performed by the consultant or a client, and wherein assessment data is stored separately from assessment business logic;
 - responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to provide the assessment business logic for multiple types of assessments for assessing businesses, wherein proprietary information and trade secrets are encoded into the data template, the assessment framework template, the suggested actions template, and the report template, and wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature;
 - responsive to determining that the intended use is conducting a self-assessment, receiving data about a business through a questionnaire, wherein the questionnaire is defined by the data template encoded with business-related domain knowledge of business practices;
 - responsive to receiving data about the business, computing at least one assessment score based on formulas and logic rules encoded in the assessment framework template;
 - responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines actions to achieve desired states of businesses; and
 - reporting results of the assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein the proprietary information and the trade secrets of the consulting assessment environment are hidden from the client.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of

ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). “*Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).”

Gillespie is directed to systems and methods for evaluating the merits of an opportunity. A survey system having a plurality of survey questions or statements relating to the opportunity is provided to a user. A user responds to the survey. Information relating to the survey questions or statements, evaluation parameters relating to the questions or statements, potential responses, evaluations parameters relating to responses, and information relating to actual responses is stored. The actual responses are evaluated against pre-defined criteria and an evaluation record is generated. At least one user is provided with information regarding the evaluation of the opportunity along with a recommendation relating to the opportunity. See *Gillespie*, abstract. *Gillespie* does not teach or suggest “determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic and conducting a self-assessment, wherein defining assessment business logic is performed by a consultant, wherein conducting a self-assessment is performed by the consultant or a client, and wherein assessment data is stored separately from assessment business logic,” as recited in amended claim 1. In addition, *Gillespie* does not teach or suggest “responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to provide the assessment business logic for multiple types of assessments for assessing businesses, wherein proprietary information and trade secrets are encoded into the data template, the assessment framework template, the suggested actions template, and the report template, and wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature,” as

recited in amended claim 1. Additionally, *Gillespie* does not teach or suggest “reporting results of the assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein the proprietary information and the trade secrets of the consulting assessment environment are hidden from the client,” as recited in claim 1.

In view of the above, Applicants respectfully submit that *Gillespie* fails to teach or suggest all of the features of amended independent claim 1, as is required under 35 U.S.C § 103. In addition, *Gillespie* does not teach or suggest the features of dependent claims 3-4, and 6-7 at least by virtue of their dependency on claim 1. Claims 8 is canceled. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 3-4, and 6-8 under 35 U.S.C § 103.

II. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 2 and 5 under 35 U.S.C. § 103 as being unpatentable over *Gillespie* in view of Griffor, U.S. Patent Application Publication No. 2002/0173999 (hereinafter “*Griffor*”). This rejection is respectfully traversed.

The Examiner states:

Claim 2: *Gillespie* does not explicitly disclose:
determining a current state of the business based on the data;
identifying a desired state for the business using the assessment framework template and the suggested actions template; and
performing a gap analysis between the current state of the business and the desired state of the business to determine the appropriate action to achieve the desired state for the business.

Griffor teaches bringing the current state of a business into alignment with its goals and purposes via a consulting process that determines appropriate actions required for that alignment (see paragraphs 15-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teachings of *Griffor* to the invention of *Gillespie* in order to take actions that would align a business with its goals. One of ordinary skill in the art would have been motivated to do so for the benefit of more efficient management of opportunities (see *Gillespie*, paragraph 1).

Claim 5: *Gillespie* discloses providing an interface for a client to conduct a self-assessment (see paragraph 36: lines 31-34).

Gillespie does not explicitly disclose gathering data about the business, wherein the data is used to determine a current state of the business, and wherein automated data synthesis is performed to relate the current state of the business to a desired state in real time.

Griffor teaches brining the current state of a business into alignment with its goal and purposes via a consulting process that determines appropriate actions required for that alignment (see paragraphs 15-19)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teachings of Griffor to the invention of Gillespie in order to take actions that would align a business with its goals. One of ordinary skill in the art would have been motivated to do so for the benefit of more efficient management of opportunities (see Gillespie, paragraph 1).

Final Office Action dated September 18, 2008, pp. 5-6.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).”

Since claims 2 and 5 depend from independent claim 1, the same distinctions between *Gillespie* and the invention recited in claim 1 applies to dependent claims 2 and 5. In addition, *Griffor* does not provide for the deficiencies of *Gillespie* with regard to amended independent claim 1. *Griffor* is directed to computer-based performance management system. *Griffor* is cited for allegedly providing for the deficiencies of *Gillespie* with regard to dependent claims 2 and 5.

Griffor does not teach or suggest “determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic and conducting a self-assessment, wherein defining assessment business logic is performed by a consultant, wherein conducting a self-assessment is performed by the consultant or a client, and wherein assessment data is stored separately from assessment business logic,” as recited in amended claim 1. In addition, *Griffor* does not teach or suggest “responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to provide the assessment business logic for multiple types of assessments for assessing businesses, wherein proprietary information and trade secrets are encoded into the data template, the assessment framework template, the suggested actions template, and the report template, and wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature,” as recited in amended claim 1. Additionally, *Griffor* does not teach or suggest “reporting results of the assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein the proprietary information and the trade secrets of the consulting assessment environment are hidden from the client,” as recited in claim 1. Thus, any alleged combination of *Gillespie* with *Griffor* still would not result in the invention recited in amended independent claim 1 from which claims 2 and 5 depend. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2 and 5 under 35 U.S.C. § 103.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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